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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Re. Appellant: Marco Scibora
Serial No.: 09/266,183
Filed: March 10, 1999
For: APPARATUS AND METHOD FOR RECORDING A CUSTOM
COMPACT DISC AT A RETAIL PREMISES

Examiner: Andrew C. Flanders
Art Unit: 2644
Confirmation No.: 5426
Attorney: Gerald E. Helget
Attorney
Docket No.: 33046.13
Additional Fees: Charge to Deposit Account 023732

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

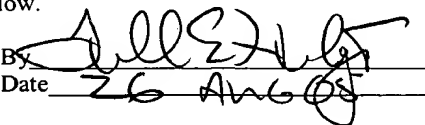
Sir:

APPELLANT'S APPEAL BRIEF UNDER 37 C.F.R. § 41.37

Appellant, by his attorney, submits one copy of this Appeal Brief, pursuant to 37 C.F.R. § 41.37 in further of the Appeal, the notice of which was filed with the United States Patent and Trademark Office on July 28, 2005, from the Final Rejection of claims 1-21 of the above-identified application, as set forth in the Final Office Action mailed on May 3, 2005. Appellant respectfully requests consideration and reversal of the Examiner's rejections of the pending claims.

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TRANSMITTAL COVER LETTER

Dear Sir/Madam:

Enclosed for filing in connection with the above-identified pending patent application, please find the following documents:

1. Appellant's Appeal Brief Under 37 C.F.R. § 41.37;
2. Check for \$250.00; and
3. Postcard receipt.

Respectfully submitted,

Dated: 26 Aug 05

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By: Gerald E. Helget
Date: 26 Aug 05



I. REAL PARTY IN INTEREST

The real party in interest is the assignee, Advanced Communication Design, Inc.

II. RELATED APPEALS AND INTERFERENCES

Applicant is unaware of any related appeals or interferences that may have a bearing on the Board's decision in the present appeal.

III. STATUS OF CLAIMS

The present application was filed on March 10, 1999 with claims 1-21. A non-final Office Action was mailed December 16, 2004. A Final Office Action was mailed May 3, 2005. Claims 1-21 stand twice rejected, remain pending, and are the subject of the present Appeal.

IV. STATUS OF AMENDMENTS

No amendments have been made since the Final Office Action.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The present invention in one respect is an apparatus (110, Fig. 3) for recording a custom compact disc at a retail premises, whereby the customer selects the desired music tracks on the compact disc from original compact discs stored digitally, comprising: a music memory (112, Fig. 3) containing a plurality of digitally-stored music selections; a plurality of preview stations (114, Fig. 3) distributed throughout the retail premises; a plurality of compact disc cutters (116, Fig. 3); and a main computer (118, Fig. 3) connected to the memory, to the preview stations, and to the compact disc cutters.

In a second aspect, the present invention is a method (Fig. 6A-6C) of recording a custom compact disc at a retail premises having a main computer and a plurality of compact disc cutters and preview stations connected to the main computer, whereby the customer selects the desired music tracks on the compact disc from original compact discs stored digitally in a music memory by scanning a barcode on the compact disc packaging at a preview station, comprising the steps (Fig. 6A-6C) of: the customer obtaining a purchase card with a unique barcode number and an authorized amount from retail premises personnel; the customer scanning a disc barcode for a compact disc to be sampled at a preview station;

playing each track corresponding to the disc barcode at the preview station; the customer selecting each track to be purchased, up to the authorized amount, by pressing a buy button at the preview station; scanning purchase card to obtain the unique barcode; keying each selected track to the unique barcode; scanning the purchase card at a checkout station to obtain the unique barcode; and recording the selected tracks keyed to the unique barcode on a compact disc cutter.

In a third aspect, the present invention is a method (Figs. 6A-6C) of recording a custom compact disc at a retail premises having a main computer and a plurality of compact disc cutters and preview stations connected to the main computer, whereby the customer selects the desired music tracks on the compact disc from original compact discs stored digitally in a music memory by scanning a barcode on the compact disc packaging at a preview station, comprising the steps (Figs. 6A-6C) of: the customer obtaining a purchase card with a unique barcode number and an authorized amount from retail premises personnel; the customer scanning a disc barcode for a compact disc to be sampled at a preview station; the preview station transmitting the disc barcode to a main computer; the main computer retrieving a digitally-stored track corresponding to the disc barcode from a music memory; the main computer transmitting the digitally-stored track to the preview station; the customer selecting the track by pressing a buy button if he wishes to purchase the track; instructing the customer to scan the purchase card at the preview station; recording and displaying the length of the selected track; notifying the customer if the total length of all selected tracks exceeds the authorized amount on the purchase card; keying the selected track to the unique barcode; scanning the purchase card at a preview station located in the retail premises check-out area; transmitting the unique barcode to the main computer; the main computer retrieving each selected track from the music memory; the main computer transmitting each selected track to a compact disc cutter; the compact disc cutter recording each selected track on a blank compact disc, producing a recorded compact disc; and the customer exchanging the purchase card for the recorded compact disc.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-9 were rejected obvious under 35 U.S.C. § 103(a) over Tsevdos in view of Alexander.

Claims 10-14 were rejected obvious under 35 U.S.C. § 103(a) over Tsevdos in view of Alexander and in further view of Kaplan.

Claim 15 was rejected obvious under 35 U.S.C. § 103(a) over Alexander in view of Tsevdos and in further view of Salisbury.

Claim 16 was rejected obvious under 35 U.S.C. § 103(a) over Alexander in view of Tsevdos and in further view of Salisbury and in further view of Hwang.

Claim 17 was rejected obvious under 35 U.S.C. § 103(a) over Tsevdos in view of Alexander and in further view of Cook

Claims 18-21 were rejected obvious under 35 U.S.C. § 103(a) over Tsevdos in view of Alexander and in further view of Kaplan and in further view of Cook.

VIII. ARGUMENT

- A. The Office Action rejected claims 1-9 under 35 USC 103(a) as being unpatentable over Tsevdos in view of Alexander. Applicant respectfully traverses the rejection.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.¹ If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of non-obviousness.²

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.³

Applicant respectfully traverses the § 103 rejection because the office action has not established a *prima facie* case of obviousness.

In the Response to Arguments, the Examiner argues that Tsevdos is a continuation of an abandoned application with a priority date of 15 October 1993, and that a continuation

¹MPEP Sec. 2142.

² Id.

³Id. (emphasis supplied)

relies on the entire disclosure of the prior application and thus teaches the invention. However, the Examiner has not cited any authority for this holding. Furthermore, the designation of an application as a continuation or a continuation-in-part is made by the Applicant. Sometimes continuation-in-part applications are fraudulently designated as continuation applications for the express purpose of preserving the priority date. Other times, an error is made. In any case, it is impossible to conclude that the earlier abandoned application teaches the invention without examining the abandoned application, which the Examiner has not done. Therefore, Appellant maintains that Tsevdos 5,734,719 has not been shown to be prior art.

- B. The Office Action rejected claims 10-14 under 35 USC 103(a) as being unpatentable over Tsevdos in view of Alexander and further in view of Kaplan. Applicant respectfully traverses the rejection.

The same arguments as to Tsevdos not being prior art apply to this claim set also.

- C. The Office Action rejected claim 15 under 35 USC 103(a) as being unpatentable over Alexander in view of Tsevdos and further in view of Salisbury. Applicant respectfully traverses the rejection.

The same arguments as to Tsevdos not being prior art apply to this claim set also.

- D. The Office Action rejected claim 16 under 35 USC 103(a) as being unpatentable over Alexander in view of Tsevdos and further in view of Salisbury and further in view of Hwang. Applicant respectfully traverses the rejection.

The same arguments as to Tsevdos not being prior art apply to this claim set also.

- E. The Office Action rejected claim 17 under 35 USC 103(a) as being unpatentable over Tsevdos in view of Alexander and further in view of Salisbury and further in view of Cook. Applicant respectfully traverses the rejection.

Cook does not disclose a plurality of scannable purchase cards each having a unique bar code keyed to the music selections chosen by the customer. There is no disclosure in Cook that the "gift card" is scannable or has a unique bar code keyed to the music selections chosen by the customer. The cited section of Cook merely states:

In a further alternative, a customer may purchase (at retail, electronically or otherwise) a "gift" certificate for a third party, who may then access the service by going to the retail establishment and supplying the gift number or token to the network machine (or an operator thereof).

This merely states how a third party may access the system. There is no disclosure of this gift certificate having a unique bar code keyed to the music selections chosen by the third party. The actual selection and ordering process in Cook is described at col. 7 lines 20-45. An order confirmation of "job" number is assigned by the management system. There is no disclosure of using any scannable barcode number on the "gift" certificate keyed to the chosen music selections. The order process of Tsevdos is described at col. 17 line 1 to col. 18 l. 15. Appellant can find no disclosure of the use of a purchase card having a unique bar code keyed to the music selections chosen by the customer.

F. The Office Action rejected claims 18-21 under 35 USC 103(a) as being unpatentable over Tsevdos in view of Alexander and further in view of Kaplan and further in view of Cook. Applicant respectfully traverses the rejection.

1. Separate argument as to claim 18.

Cook does not disclose step (a) of the customer obtaining a purchase card with a unique barcode number and an authorized amount from retail premises personnel. Cook does not disclose steps (e), (f), (g), or (h). There is no disclosure in Cook that the "gift card" is scannable or has a unique bar code keyed to the music selections chosen by the customer. The cited section of Cook merely states:

In a further alternative, a customer may purchase (at retail, electronically or otherwise) a "gift" certificate for a third party, who may then access the service by going to the retail establishment and supplying the gift number or token to the network machine (or an operator thereof).

This merely states how a third party may access the system. There is no disclosure of this gift certificate having a unique bar code keyed to the music selections chosen by the third party. The actual selection and ordering process in Cook is described at col. 7 lines 20-45. An order confirmation of "job" number is assigned by the management system. There is no disclosure of using any scannable barcode number on the "gift" certificate keyed to the chosen music selections. The order process of Tsevdos is described at col. 17 line 1 to col. 18 l. 15. Appellant can find no disclosure of the use of a purchase card having a unique bar code keyed to the music selections chosen by the customer.

2. Separate Argument as to claim 19.

Cook does not disclose steps (a), (h), (j), (k), (l) or (q). There is no disclosure in Cook that the "gift card" is scannable or has a unique bar code keyed to the music selections chosen by the customer. The cited section of Cook merely states:

In a further alternative, a customer may purchase (at retail, electronically or otherwise) a "gift" certificate for a third party, who may then access the service by going to the retail establishment and supplying the gift number or token to the network machine (or an operator thereof).

This merely states how a third party may access the system. There is no disclosure of this gift certificate having a unique bar code keyed to the music selections chosen by the third party. The actual selection and ordering process in Cook is described at col. 7 lines 20-45. An order confirmation of "job" number is assigned by the management system. There is no disclosure of using any scannable barcode number on the "gift" certificate keyed to the chosen music selections. The order process of Tsevdos is described at col. 17 line 1 to col. 18 l. 15. Appellant can find no disclosure of the use of a purchase card having a unique bar code keyed to the music selections chosen by the customer.

3. Separate argument as to claim 21.

Cook also does not disclose the further limitation of claim 21 of the customer purchasing the purchase card after selecting tracks to be purchased. The "gift" card is apparently purchased before selecting any tracks and then given to a third party for that party to choose his or her music selections.

In view of the foregoing, Appellant asks the Board to overturn the Examiner's rejections and allow all claims.

Respectfully submitted,

Dated: 26 Aug 05

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CLAIMS APPENDIX

In the claims:

1. An apparatus for recording a custom compact disc at a retail premises, whereby the customer selects the desired music tracks on the compact disc from original compact discs stored digitally, comprising:

- (a) a music memory containing a plurality of digitally-stored music selections;
- (b) a plurality of preview stations distributed throughout the retail premises;
- (c) a plurality of compact disc cutters; and
- (d) a main computer connected to the memory, to the preview stations, and to the compact disc cutters.

2. The apparatus of claim 1, wherein the memory comprises at least one hard disc drive.

3. The apparatus of claim 1, wherein the music memory is located remotely from the main computer.

4. The apparatus of claim 1, wherein the digitally-stored music selections are uncompressed.

5. The apparatus of claim 1, wherein the digitally-stored music selections are compressed.

6. The apparatus of claim 5, wherein the digitally-stored music selections are compressed using MP3 encoding.

7. The apparatus of claim 5, wherein the digitally-stored music selections are compressed using ADPCM encoding.

8. The apparatus of claim 5, wherein the digitally-stored music selections are compressed using Real Audio encoding.

9. The apparatus of claim 5, wherein the digitally-stored music selections are compressed using Liquid Audio encoding.
10. The apparatus of claim 1, wherein each of the plurality of preview stations further comprises a bar-code scanner, a digital display, sound reproduction means, track selection means, and compact disc purchase means.
11. The apparatus of claim 10, wherein the sound reproduction means is a speaker.
12. The apparatus of claim 10, wherein the sound reproduction means is a headphone.
13. The apparatus of claim 10, wherein the track selection means further comprises a skip forward button and a skip back button.
14. The apparatus of claim 10, wherein the compact disc purchase means comprises a buy button.
15. The apparatus of claim 1, wherein each of the plurality of compact disc cutters further comprises storage for a number of blank compact discs, a mechanism for removing a blank compact disc from the compact disc storage, a mechanism for recording music selected from the music memory on a blank compact disc, and a printer adapted to print identifying information on the compact disc.
16. The apparatus of claim 15, wherein the identifying information comprises the date of manufacture, the retailer's name, and the titles of the music selections cut into the compact disc.
17. The apparatus of claim 1, further comprising a plurality of scannable purchase cards each having a unique bar code keyed to the music selections chosen by the customer.
18. A method of recording a custom compact disc at a retail premises having a main computer and a plurality of compact disc cutters and preview stations connected to the main computer, whereby the customer selects the desired music tracks on the compact disc from original compact discs stored digitally in a music memory by scanning a barcode on the compact disc packaging at a preview station, comprising the steps of:

- (a) the customer obtaining a purchase card with a unique barcode number and an authorized amount from retail premises personnel;
- (b) the customer scanning a disc barcode for a compact disc to be sampled at a preview station;
- (c) playing each track corresponding to the disc barcode at the preview station;
- (d) the customer selecting each track to be purchased, up to the authorized amount, by pressing a buy button at the preview station;
- (e) scanning the purchase card to obtain the unique barcode;
- (f) keying each selected track to the unique barcode;
- (g) scanning the purchase card at a checkout station to obtain the unique barcode; and
- (h) recording the selected tracks keyed to the unique barcode on a compact disc cutter.

19. A method of recording a custom compact disc at a retail premises having a main computer and a plurality of compact disc cutters and preview stations connected to the main computer, whereby the customer selects the desired music tracks on the compact disc from original compact discs stored digitally in a music memory by scanning a barcode on the compact disk packaging at a preview station, comprising the steps of:

- (a) the customer obtaining a purchase card with a unique barcode number and an authorized amount from retail premises personnel;
- (b) the customer scanning a disc barcode for a compact disc to be sampled at a preview station;
- (c) the preview station transmitting the disc barcode to a main computer;
- (d) the main computer retrieving a digitally-stored track corresponding to the disc barcode from a music memory;

- (e) the main computer transmitting the digitally-stored track to the preview station;
- (f) the preview station converting the digitally-stored track to analog and then to sound at the preview station;
- (g) the customer selecting the track by pressing a buy button if he wishes to purchase the track;
- (h) instructing the customer to scan the purchase card at the preview station;
- (i) recording and displaying the length of the selected track;
- (j) notifying the customer if the total length of all selected tracks exceeds the authorized amount on the purchase card;
- (k) keying the selected track to the unique barcode;
- (l) scanning the purchase card at a preview station located in the retail premises check-out area;
- (m) transmitting the unique barcode to the main computer;
- (n) the main computer retrieving each selected track from the music memory;
- (o) the main computer transmitting each selected track to a compact disc cutter;
- (p) the compact disc cutter recording each selected track on a blank compact disc, producing a recorded compact disc; and
- (q) the customer exchanging the purchase card for the recorded compact disc.

20. The method of claim 19, wherein the customer purchases the purchase card before selecting tracks to be purchased.

21. The method of claim 19, wherein the customer purchases the purchase card after selecting tracks to be purchased.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.